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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,004	04/10/2001	Artur Pedyczak	11014-24/MG	9570

7590

09/09/2002

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EXAMINER

NGUYEN, QUANG

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 09/09/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/829,004

Applicant(s)

PEDYCZAK ET AL.

Examiner

Quang Nguyen, Ph.D

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claims 1-22 are pending in the present application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group Restriction:

- I. Claims 1-4, 10-11, 14-15, 17-19 and 21-22, drawn to a prostate-specific antigen (PSA) derived peptide that is capable of eliciting an immune response comprising a sequence of the Formula I, a composition and a fusion protein comprising the same, and methods of eliciting an immune response or of treating cancer comprising administering to an animal an effective amount of the same, classified in class 424, subclass 185.1; class 530, subclass 300, for examples.
- II. Claims 5-9, 12-13, 16 and 20, drawn to a nucleic acid molecule encoding a PSA derived peptide comprising a sequence of the Formula I, an expression vector, a transformed host cell, a composition comprising the same, and methods of eliciting an immune response or treating cancer comprising administering to an animal an effective amount of the same nucleic acid molecule, classified in class 514, subclass 44; class 435, 320.1, 455, for examples.

The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups I and II are distinct each from the others because the prostate-specific antigen (PSA) derived peptide of Group I is chemically and structurally distinct from a nucleic acid molecule encoding the same PSA derived peptide of Group II. While the PSA derived peptide of Group I is composed of amino acid residues, the nucleic acid molecule of Group II is made up of nucleotide residues. Furthermore, the PSA derived peptide of Group I is not required for the methods of Group II, and vice versa.

Because these inventions are distinct for the reasons set forth above and have acquired a separate status in the art because of their recognized divergent subject matter, separate search requirements, and undue burden for the examiner, restriction for examination purposes as indicated is proper.

Species Restriction:

Should Applicants elect the invention of Group I, claims 1-4, 10-11, 14-15, 17-19 and 21-22 are generic to a plurality of disclosed patentably distinct species comprising:

(a) SEQ ID NO:1; (b) SEQ ID NO:2; and (c) SEQ ID NO:3.

Applicant is required under 35 U.S.C. 121 to elect a specifically named species as indicated above.

Should Applicants elect the invention of Group II, claims 5-9, 12-13, 16 and 20 are generic to a plurality of disclosed patentably distinct species comprising:

(a) SEQ ID NO:7; (b) SEQ ID NO:8; and (c) SEQ ID NO:9.

Applicant is required under 35 U.S.C. 121 to elect a specifically named species as indicated above.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

Art Unit: 1636

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17 (h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang Nguyen, Ph.D., whose telephone number is (703) 308-8339.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's mentor, Dave Nguyen, may be reached at (703) 305-2024, or SPE, Irem Yucel, Ph.D., at (703) 305-1998.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tracey Johnson, whose telephone number is (703) 305-2982.

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1636.

Quang Nguyen, Ph.D.


DAVE T. NGUYEN
PRIMARY EXAMINER